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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/901,000 | 07/09/2001 | Teruo Kamada | SHM/12585 | 6853 |

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EXAMINER

FISCHMANN, BRYAN R

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3618

DATE MAILED: 09/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/901,000

Applicant(s)
KAMADA, ET AL

Examiner
Bryan Fischmann

Art Unit
3618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 26, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-8 are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-3, drawn to a vehicular body panel, classified in class 280, subclass 69.2.
 - II. Claims 4-8, drawn to a method (claims 4-6) and apparatus (claims 7 and 8) for manufacturing the body panel, classified in class 29, subclasses 505 (method) and 564.1 (apparatus).

2. The inventions are distinct, each from the other because of the following reasons:

A) Regarding the method claims, Inventions I and II are related as process (method) of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed may be used to form other non-vehicle structures, such as metal furniture (desks, chairs, etc.), or portions thereof that include a backing plate for reinforcement. Also, the body panel may be made by other processes, such as cutting the body panel by machine, such as a saw, or laser cutter, and then by joining the blank material and backing plate by "tack welding", if metal, or if non-metal, the blank material and backing plate being fabricated out of a thermoplastic in a mold and then being vulcanized together.

B) In addition, regarding the apparatus claims, Inventions I and II are also related as apparatus and product made. The inventions in this relationship are distinct if either or both of

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the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case, the product does not require the apparatus claimed in claims 7 and 8 for manufacture of the body panel. Separate cutting and caulking apparatuses, as opposed to combining both operations in one apparatus may be used to manufacture the body panel. Also, the body panel could be manufactured by utilizing other apparatus, such as an N/C controlled saw cutter, or laser cutter and the backing plate then joined to the hood blank by spot welding, or using adhesives.

Regarding the method and apparatus claims, consideration was given to restricting the method from the apparatus, resulting in a "three way", as opposed to a "two way" restriction. The method (process) is "restrictable" from the apparatus, if either, or both: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). It is not believed that the process and apparatus claims satisfy either of these criteria. Due to this, a "two-way", versus a "three-way" restriction was made.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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4. A telephone call was made to David E. Spaw on 9-17-02 to request an oral election to the above restriction requirement. A second call was made to David E. Spaw on 9-18-02 to state that due to circumstances surrounding internal procedures at the PTO regarding the transfer of cases toward the end of the fiscal year, that it was requested that Mr. Spaw agree to a written restriction requirement, as opposed to an oral election. Mr. Spaw was agreeable to a written restriction. A transfer of this Application to another art unit is considered likely as a result of the restriction requirement. Currently this Application is assigned to Art Unit 3618.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement may be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan Fischmann whose telephone number is (703) 306-5955.

 9-18-2
BRYAN FISCHMANN
PATENT EXAMINER